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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) | |
|---|---|--------------------------|--|
| | | NC96,202 | |
| | Application Number | Filed | |
| | 10/808266 | March 17, 2004 | |
| | First Named Inventor Teddy M Keller et al. | | |
| | Art Unit | Examiner | |
| | 1711 | D. Truong | |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number 46,746</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34.</p> <p>Signature: <u>Joseph T. Grunkemeyer</u> Typed or printed name</p> <p>(202) 404-1556 Telephone number</p> <p>September 7, 2005 Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of 1 forms are submitted.</p> | | | |

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Dated: 9/7/05

Signature: Joseph T. Grunkemeyer

(Joseph T. Grunkemeyer)

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OCT 14 2005

In the application of: Keller et al.

Serial No.: 10/808,266

Filed: 03/17/2004

For: OLIGOMERIC HYDROXY ARYLETHER PHTHALONITILES AND SYNTHESIS
THEREOF

Examiner: Truong, Duc

Art Group Unit: 1711

Honorable Commissioner of Patents

PO Box 1450

Alexandria, VA 22313-1450

September 7, 2005

PRE-APPEAL REQUEST FOR REVIEW

Sir:

This Request is in response to the Final Rejection of 05/13/2005 and the Advisory Action of 08/23/2005. It is submitted with a Notice of Appeal and a Petition for Extension.

The Examiner has maintained the rejection of claims 14-21 and 38-46 under 35 U.S.C § 103(a) as allegedly unpatentable over Keller et al. (US 4,256,471).

On 03/03/2005 Applicants submitted a declaration in response to the non-final rejection of 12/08/2004 to show that the Keller reference was non-enabling for the presently claimed compounds. In the final rejection, the Examiner stated that the declaration is not commensurate with the scope of the claims. It was not stated what part of the claim was not covered by the declaration. The declaration states that "the Ullmann ether synthesis referred to in the Keller reference (US Patent No. 4,259,471) cannot be used to make oligomeric or polymeric aryl ethers in high yield and high molecular weight." (Paragraph 3.) Thus, the scope of the declaration covers all polymeric aryl ethers, which is another term for polyaromatic ethers. Claim 14 recites thermosets made from phthaloniles containing certain polyaromatic ethers and claim 38 recites a

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Joseph T. Grunkemeyer

Serial No.: 10/808,266

PATENT APPLICATION
Docket No.: NC 96,202

method of making the thermoset. Thus the declaration is at least commensurate with the scope of the claims, and the claims should be examined in light of the correct scope of the declaration.

The Examiner has maintained the rejection of claims 47-56 under 35 U.S.C § 103(a) as allegedly unpatentable over Keller et al. (US 5,352,760) or Keller et al. (US 5,464,926).

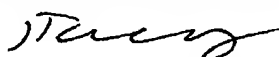
Applicant has argued that the references do not disclose the use of a copper compound in the first reacting step (response of 08/11/2005, page 4, line 16-page 5, line 4). The Examiner admitted that the references do not disclose a copper compound in the first step (final rejection, p.3, lines 8-9). However, the Examiner stated that this is "not found persuasive as since they all form the same products." (Advisory action, item 11.) The Examiner is inappropriately citing to a product in the reference as disclosing a process step in the present claims.

The Examiner also stated that "Applicant's arguments are also based on the reactants in that the references disclose a dihaloaromatic group containing an R group that is an electron-withdrawing group. This is incorrect in stating that (see non-final office action)." (Advisory action, item 11.) Nowhere else in the record is the presence of the electron-withdrawing group disputed by the Examiner. This argument does not restrict the claim to particular reactants, but only explains that the copper compound allows for a greater range of reactants. Applicants' primary argument regarding the lack of a *prima facie* case remains that the process step of using copper is not disclosed in the references.

In view of the foregoing, it is submitted that the application is now in condition for allowance.

In the event that a fee is required, please charge the fee to Deposit Account No. 50-0281, and in the event that there is a credit due, please credit Deposit Account No. 50-0281.

Respectfully submitted,



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